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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,392

03/27/2007

Jun Kamite

5404/151

3870

757 7590 12/24/2009
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EXAMINER

HAIDER, SAIRA BANO

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,392	Applicant(s) KAMITE ET AL.	
	Examiner SAIRA HAIDER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/06, 8/29/06, 06/02/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-13 are objected to because of the following informalities: Claim 1 contains two periods to mark the end of two sentences within one claim; however, a claim can only be one sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Manabe (WO 01/00727).

4. The citations to Manabe are from the English language equivalent, US 6,555,620).

5. Manabe discloses an electrically-conductive composition comprising the following components (A) to (E) (claim 1):

6. (A) An isobutylene polymer having at least one alkenyl group which can undergo hydrosilylation reaction per molecule;

7. (B) A compound having at least two hydrosilyl groups per molecule;

8. (C) A hydrosilylation catalyst;

9. (D) An acetylene alcohol having the following structure: wherein R14 and R15 each independently represent a hydrogen atom, alkyl group or aryl group, with the proviso that R14 and R15 may be connected to each other to form a ring; and

10. (E) An electrical conductivity-providing material.

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11. Wherein components (A), (B), (C) and (E) read on the claimed components (A), (B), (C) and (F), respectively.

12. In reference to the claimed component (D), Manabe notes the inclusion of silane coupling agents including those with functional groups such as epoxy groups (col. 10, ll. 60 to col. 11, ll. 8).

13. In reference to claim 6, Manabe discloses that the alkenyl group which can undergo hydrosilylation reaction in said polymer as component (A) exists at the terminal of said polymer (claim 2). In reference to claim 7, Manabe noted that the main chain of component (A) comprises a butoxystyrene (col. 3, lines 57-64).

14. In reference to claim 9, it is noted that since the prior art discloses the identical chemical structures, the properties applicant discloses and/or claims (Asker-C hardness) are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note, that because the reference does not expressly disclose or address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Disclose the same compound(s) inherently discloses the corresponding properties. The references cannot possibly disclose or address all of the properties, but implicitly all of the properties are present.

15. In reference to claim 10, Manabe discloses that the electrically conductive-elastic composition is used to coat metallic shafts, wherein additional layers may be provided on the outside of the electrically conductive-elastic layer (col. 11, ll. 65 to col. 12, ll. 17).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manabe (WO 01/00727).

18. In reference to claim 2, Manabe fails to disclose the weight ratio of the silane coupling agent, however, the reference notes that the coupling agents may be included based on necessity.

Accordingly, the amount of silane coupling agent is recognized as a result-effective variable because changing it will clearly affect the type of product obtained. Wherein an increase in the amount of the agent will result in a greater adhesivity. Thus it would have been obvious to one of ordinary skill in the art to utilize a coupling agent with in the claimed amounts so as to produce the desired end results. See MPEP § 2144.05 (B).

19. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manabe (WO 01/00727) in view of Nishimura (US 5,962,148).

20. In reference to claims 3 and 4, Manabe applies as discussed above and notes the inclusion of a silane coupling agent with functional epoxy groups to enhance the adhesivity, but fails to disclose the alkenyl or hydrogen groups, as per claims 3-4. Thus attention is directed to Nishimura which discloses well known silane coupling agent including vinyl triethoxysilane, which meets the claimed limitation (col. 6, lines 42-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the silane coupling agent of Nishimura in the invention of Manabe. Wherein the motivation for the inclusion is that Manabe notes that silane coupling agents with functional epoxy groups and Nishimura discloses well known silane coupling agents.

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21. In reference to claim 5, it is noted that since the combination of the prior art references teach the identical chemical structures, the properties applicant discloses and/or claims (reaction to form component (E) via the reaction of (B) and (D)) are necessarily present.. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note that because the reference does not expressly teach or address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Teaching the same compound(s) inherently discloses the corresponding properties. The references cannot possibly teach or address all of the properties, but implicitly all of the properties are present.

22. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manabe (WO 01/00727) in view of Krotchko (US 4,576,845).

23. Manabe discloses that the electrically conductive-elastic composition is used to coat metallic shafts, wherein additional layers may be provided on the outside of the electrically conductive-elastic layer (col. 11, ll. 65 to col. 12, ll. 17). However, Manabe fails to disclose the claimed primer and urethane layers. Thus attention is directed to the Krotchko reference, which discloses a metal core, comprising an intermediate layer and a polyurethane cover (abstract). Krotchko notes post application of the intermediate conductive layer, this layer is surface treated to make it acceptable for bonding of the polyurethane layer, according, the conductive layer is considered to be primed. Wherein it would have been obvious to prime the conductive layer of Manabe post application to the metallic shaft in order to enhance the bonding of the polyurethane layer. Wherein the polyurethane layer readily dissipates heat and permits operation at higher speeds and pressures (col. 5, lines 16-40).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

Saira Haider
Examiner
Art Unit 1796